



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE

United States Patent and Trademark Office

Address: COMMISSIONER FOR PATENTS

P.O. Box 1450

Alexandria, Virginia 22313-1450

www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/826,557	04/15/2004	Charles Marshall		2102

7590 05/28/2008
CHARLES MARSHALL
MARSHALL MEDIA, INC
655 NORTH CENTRAL AVE. 17th FLOOR
GLENDALE, CA 91203

EXAMINER

MCINTYRE, CHARLES AARON

ART UNIT	PAPER NUMBER
----------	--------------

4176

MAIL DATE	DELIVERY MODE
-----------	---------------

05/28/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/826,557

Applicant(s)

MARSHALL, CHARLES

Examiner

C. Aaron McIntyre

Art Unit

4176

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) none is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-36 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SE/US)
Paper No(s)/Mail Date 20051107 and 20041004.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-9, 12, 14-15, 17-23, 25-27, and 29-36 are rejected under 35 U.S.C. 102(b) as being anticipated by Hooban (5,930,768).

3. Referring to **claims 1, 6, 7, and 26**, Hooban discloses a method for automated on-demand product manufacturing and fulfillment (abstract), comprising: receiving an order for a product without human intervention (col. 7, ll. 3-15, *their particular order is URL-encoded and passed to the server*); requesting payment for the order without human intervention (col. 7, ll. 3-15, *prompt the user for credit card information*); manufacturing the product without human intervention (col. 8, ll. 9-23, *production device driver*); placing the product into a shipping container without human intervention (col. 3, ll. 35-43, *utilizing automated packaging and shipping systems*); and adding a delivery address to the shipping container without human intervention (col. 4, ll. 52-67, col. 5, ll. 1-3, *the CD-R media is packaged, postmarked, and shipped to the user, preferably by*

an automated packaging and shipping system that is physically located at express shipping facilities).

4. Referring to **claim 2**, Hooban discloses wherein the order is received via the Internet (abstract).

5. Referring to **claims 3, 19, and 32**, Hooban discloses adding indicia to the product without human intervention (col. 4, ll. 52-67, col. 5, ll. 1-3, *After burning, the CD-R media is packaged, postmarked, and shipped to the user, preferably by an automated packaging and shipping system that is physically located at express shipping facilities).*

6. Referring to **claims 4, 20, and 33**, Hooban discloses packaging the product in a presentation package without human intervention (col. 3, ll. 35-43, *The CD is removed from the CD-R machine, packaged with user selected artwork and liner notes, and shipped to the user).*

7. Referring to **claims 5, 21, and 34**, Hooban discloses adding at least one of postage and delivery payment information to the shipping container (col. 4, ll. 52-67, col. 5, ll. 1-3, *After burning, the CD-R media is packaged, postmarked, and shipped to the user, preferably by an automated packaging and shipping system that is physically located at express shipping facilities).*

8. Referring to **claims 8 and 27**, Hooban discloses wherein the order is received from a geographically distant computing device based on human input to the computing device (col. 2, ll. 47-59, *system also includes an Internet (TCP/IP) server that interacts with the user via the user's client interface*).

9. Referring to **claim 9**, Hooban discloses wherein the geographically distant computing device is a personal computer located in at least one of a human's home and workplace (col. 5, ll. 20-27, *allows potential customers to communicate with the system regardless of their type of computer and operating system*).

10. Referring to **claim 12**, Hooban discloses hosting a website listing at least some of the content available for ordering (col. 4, ll. 17-32, *Ideally, the client has a robust graphical browser installed allowing for Hypertext Markup Language (HTML) forms input to a Hypertext Transport Protocol (HTTP) based server for the World Wide Web (WWW) and the capability to run applets on a Java virtual machine*).

11. Referring to **claim 14**, Hooban discloses wherein the order is received from a local computing device based on human input to the computing device (col. 5, ll. 20-27, *allows potential customers to communicate with the system regardless of their type of computer and operating system*).

12. Referring to **claims 15 and 29**, Hooban discloses wherein the order includes an identification of the content, delivery information, and payment information (col. 3, ll. 3-9, *After making all desired selections, the user is asked to enter a credit card number or some other type of billing information preferably encrypted for security purposes. Once the user has verified that he/she wants a particular compilation of songs in a desired particular order, the information is passed to a server for fulfillment in which a customized product is produced*).

13. Referring to **claims 17 and 30**, Hooban discloses wherein the media is selected from a group consisting of compact disc (CD), digital video disc (DVD), and videotape (col. 8, ll. 44-63, *information is then transferred to the CD-R for physically burning the image to the CD-R media via the CD-R machine (for example a Hewlett Packard) (Step 11900). The information can also be sent to other types of digital media*).

14. Referring to **claims 18 and 31**, Hooban discloses wherein the content on the media is selected from a group consisting of audio, video, text, software, tables, photos, and combinations thereof (col. 1, ll. 13-29, *products consist of machine readable media containing collections of data from a variety of worldwide source databases*).

15. Referring to **claim 22**, Hooban discloses calculating shipping cost for shipping the shipping container with the media therein (col. 2, ll. 38-46, *based on shipping costs*, col. 7, ll. 16-38, *All the appropriate calculations are made, including royalties on copyrighted material, media, taxes and shipping*).

16. Referring to **claims 23 and 35**, Hooban discloses performing the method simultaneously for at least two different pieces of media (col. 5, ll. 53-60, *The server should be robust enough to handle multiple simultaneous requests in a secure manner*).

17. Referring to **claims 25 and 36**, Hooban discloses calculating a royalty for the content and submitting the royalty to at least one of an author of the content and a representative of the author (col. 2, ll. 38-46, *based on shipping costs*, col. 7, ll. 16-38, *All the appropriate calculations are made, including royalties on copyrighted material, media, taxes and shipping*).

Claim Rejections - 35 USC § 103

18. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 10, 11, 13, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hooban (5,930,768) in view of Pugliese, III et al. (2001/0044751).

20. Referring to **claims 10, 11, 13, and 28**, Hooban discloses a method for automated on-demand manufacturing and fulfillment of media, including an order received from the Internet (Hooban: col. 5, ll. 20-27, *The WWW infrastructure provides for a universal and standard communication medium. This allows potential customers to communicate with the system regardless of their type of computer and operating system*), as applied above in the rejection of claims 7, 8, and 26 under 35 U.S.C. 102(b), but Hooban does not explicitly disclose that the method includes receiving an order from a retail location, kiosk, or handheld device.

However, Pugliese, III et al. disclose a similar method, which method of Pugliese, III et al. indeed include receiving an order from a retail location, kiosk, or handheld device (Pugliese: abstract, *The shopper accesses the ShopLive system through various portals. They can be a PC, Web TV, mall kiosk, store kiosk, mobile terminal, screen telephone or any other communication device capable of connecting to a communications network*).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Hooban so as to have included an receiving an order from a retail location, kiosk, or handheld device, in accordance with the teaching of Pugliese, III et al., in order to provide the customer with a wide variety of

ordering locations, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

21. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooban (5,930,768) in view of Bernard et al. (5,918,213).

22. Referring to **claim 16**, Hooban discloses a method for automated on-demand manufacturing and fulfillment of media, as applied above in the rejection of claim 7 under 35 U.S.C. 102(b), but Hooban does not explicitly disclose that the user could create an account.

However, Bernard et al. disclose a similar method, which method of Bernard et al. indeed include obtaining delivery information and payment information from a user account (col. 3, ll. 63-67, col. 4, ll. 1-7, *To facilitate automated order processing, a customer can become a "member" of the system and have a membership profile on file containing important customer information. This membership information can include data such as the customer's name and shipping address, customer preferences, and customer payment information such as credit card, debit card or other payment information*).

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Hooban so as to have included obtaining delivery information and payment information from a user account, in accordance with the teaching of Bernard et al., in order to provide the customer with a faster checkout time and greater convenience, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

23. Claim 24 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hooban (5,930,768) in view of official notice.

24. Referring to **claim 24**, Hooban discloses a method for automated on-demand manufacturing and fulfillment of media, as applied above in the rejection of claim 7 and 23 under 35 U.S.C. 102(b), but Hooban does not explicitly disclose wherein the two different pieces of media are associated with the same order and are to be sent in the same shipping container, wherein a size of the shipping container is selected based on a collective size of the media.

However, official notice is taken that two different pieces of media associated with the same order are regularly packaged together in the same shipping container with said container varying in size based upon the contents.

Therefore, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to have modified the system of Hooban so as to have included the ability to include two different pieces of media associated with the same order and sent in the same shipping container, wherein a size of the shipping container is selected based on a collective size of the media, in accordance with the teaching of the official notice, in order to provide the customer with a single shipment for their order, since so doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

Conclusion

25. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. Buckley et al. disclose a computer controlled system for vending personalized products. U.S. Patent No. 5,546,316 (issued Aug 13, 1996).
- b. Dockes et al. disclose a system and method for production of customized compact discs on demand. U.S. Patent No. 5,959,944 (issued Sep. 28, 1999), See also, U.S. Patent No. 6,011,758 (issued Jan 4, 2000).
- c. Alloul et al. disclose a method and system for presenting real-time multimedia product information, such as catalog information, to customers, who can then place orders. U.S. Patent No. 6,032,130 (issued Feb. 29, 2000).

d. Lasnier et al. disclose an Internet shopping system and method. U.S. Publication No. 2002/0077927 (published Jun. 20, 2002).

e. Kritt et al. disclose a method and system for product fulfillment in an automated manufacturing system. U.S. Publication No. 2002/0188514 (published Dec. 12, 2002).

f. Cook discloses a system for selling, manufacturing and distributing a custom digital data product from retail stores, over the Internet, over the telephone, or by electronic means. U.S. Patent No. 6,496,744 (issued Dec. 17, 2002).

g. Marshall, the present applicant, discloses a similar system and method, which has been considered for possible double patenting. U.S. Publication No. 2005/0234783 (published Oct. 20, 2005).

26. Any inquiry concerning this communication or earlier communications from the examiner should be directed to C. Aaron McIntyre whose telephone number is (571) 270-5401. The examiner can normally be reached on Monday to Thursday 9-6 ET.

27. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jerry O'Connor can be reached on (571) 272-6787. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

28. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/C. A. M./
Examiner, Art Unit 4176
May 13, 2008

/Gerald J. O'Connor/
Supervisory Patent Examiner
Group Art Unit 4176